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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,499	12/30/2004	Fioravante Rotundo	2518-1061	5380
466	7590	12/21/2005	EXAMINER	
YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202			ELDRED, JOHN W	
			ART UNIT	PAPER NUMBER
			3641	

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/519,499	Applicant(s) ROTUNDO, FIORAVANTE	
	Examiner J. Woodrow Eldred	Art Unit 3644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-14 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 9-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12302004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, it is not clear how the stock elements can rotate relative to each other, since they are disclosed as being attached to each other by two rigid pins and the structure involved with the added screw attachment is not clearly described. Also, Element 1 is described as “integral” to the breechblock, but it appears clear from the drawings (i.e. Figure 2) that it is not integral but merely attached to the breechblock.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 9-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 9, “the shooter” and “the breechblock” have no antecedent basis in the claims.

In claim 9, “rotate according to element 2” is vague and unclear. Is this trying to convey that element 1 rotates “relative” to element 2? In claim 10, “sufficiently rigid” is vague and indefinite. In claim 10, the attachment structure of the pins, plates, and stock elements are vague, indefinite, and alternative. In claim 9, “the plates imbedded” has no antecedent basis in the claims. In claim 11, “the height of the pins” has no antecedent basis in the claims. In claim 11, it is unclear if the pins themselves change height, or if the position of the pins change. In claim 12, “can take place” is indefinite since it is not clear if this is a claimed limitation. In claim 12, “by inserting shims between the two elements” is vague and indefinite since it is not clear how or where the shim is being

structurally claimed. In claim 13, “the hooking of the pins” has no antecedent basis in the claims and it is not clear what structurally comprises “the hooking”. In claim 13, “the screws 13” have no antecedent basis in the claims, because parent claim 10 disclosed “screws 12”. In claim 14, “appropriate regulations” is vague and indefinite. In claim 14, “the barrels” and “the reciprocal translation” have no antecedent basis in the claims. In claim 14, it is unclear if the elements rotate on both planes and translate on both planes.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 9-11, 13, and 14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Carey (5,392,553).

See especially Figure 1.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carey (5,392,553) in view of Hickman (4,203,244).

Carey discloses a gun with an adjustable gunstock where the gunstock comprises a first element attached to the breechblock and a second element that is rotatably attached to the first element by at least two rigid pins that can be adjusted by screws. Note that in Carey, element number 10 corresponds to claimed element 1; connected elements 12 and 14 (see column 3, lines 47-53) correspond to claimed element 2; and at least elements 122 and 44 correspond to the two rigid pins, and elements 132 and 42 correspond to the adjusting

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screws. Carey fails to show that a shim can be used in the adjustment in the vertical direction. Hickman teaches in column 2, line 64-column 3, line 1 teaches that it is well known to use shims to perform vertical adjustment of stock elements on a firearm. Motivation to combine is the mere addition of a well known means for adjusting the position of the stock elements in order to place the elements in a particular desired position. To employ the teachings of Hickman on the stock of Carey and have a shim for vertical adjustment is considered to have been obvious to one having ordinary skill in the art.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Griggs, Barrett, Carey (5,031,348), Gregory, and Pickering.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Woodrow Eldred whose telephone number is 571-272-6901. The examiner can normally be reached on Monday to Thursday, from 8:00 a.m. to 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 571-272-7045. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



J. Woodrow Eldred
Primary Examiner
Art Unit 3644

JWE